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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,949	04/01/2005	Takayoshi Mamine	09812.0391-00000	5510
22852	7590	11/25/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
BABIC, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
1637				
MAIL DATE		DELIVERY MODE		
11/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,949

Applicant(s)

MAMINE ET AL.

Examiner

CHRISTOPHER M. BABIC

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 11, 2008 has been entered. Claim(s) 1-4 are pending.

Claim Rejections - 35 USC § 103 - Withdrawn

Applicant's claim amendments are sufficient to overcome the rejection of claim(s) 1, 3, and 4 over Quake, Wachter, and Washizu. Thus, the rejection has been withdrawn.

Claim Rejections - 35 USC § 103 - New Grounds

The following rejection(s) are made in view of Applicant's amendments. The extensive amendments to claim 1 now require active method steps (e.g. vibrating and exciting) that were previously recited as an "intended use" of the required apparatus parts, and thus, were not required by the claimed invention. The new grounds of rejection presented below reflect such changes to the claimed invention.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claim(s) 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quate et al. (U.S. 6,203,983 B1) in view of Washizu et al. ("Electrostatic manipulation of DNA in microfabricated structures," IEEE Trans. Ind. Applicat., vol. 26, pp. 1165-1172, 1990), and in further view of Wachter et al. (U.S. 5,445,008), and in further view of Daratchiev et al. (U.S. 6,457,360 B1).

With regard to claims 1 and 3, Quate teaches methods for detecting hybridization of target nucleic acids (fig. 1-4; col. 5-6, for example) comprising: providing a cantilever

comprising immobilized oligonucleotides (fig. 1, 11; col. 4, lines 25-40, for example); introducing a sample comprising oligonucleotides complementary to that of those immobilized on the cantilever (col. 4, lines 25-40, for example); and detecting hybridization based on a change in resonant frequency (col. 4, lines 25-40, for example).

Quate does not expressly teach forming an uneven electric field at the surface of immobilized oligonucleotides, actively vibrating and exciting the cantilever by using a driving source, or detecting the vibration amplitude of the cantilever by measuring a voltage of a resistor coupled with the cantilever.

With regard to the formation of an uneven electric field at the surface of immobilized oligonucleotides as well as claim 4, Washizu provides a supportive disclosure that teaches the application of an uneven electric field to immobilize and stretch DNA molecules (pg. 1166, section III, experimental method, for example). The reference expressly teaches that the methods can be used to neatly align DNA molecules on substrates within biosensors as well as position DNA molecules on the edge of strips or pinpoints (pg. 1171, col. 1, for example).

With regard to the vibration of the cantilever through the use of a driving force, Wachter provides a supportive disclosure that teaches actively vibrating and exciting a coated cantilever with a driving force (fig. 1, 10, 12, 14; col. 1, lines 45-end, for example), exposing a target compound to the oscillating cantilever (col. 1, lines 45-end, for example), and detecting the binding of the target to the cantilever by measuring change in resonant frequency (col. 1, lines 45-end; fig. 5, for example).

With regard to the vibration amplitude of the cantilever by measuring a voltage of a resistor coupled with the cantilever, Daraktchiev provides a supportive disclosure that teaches determining the resonance frequency of the free end of the cantilever by measuring an output voltage of the piezo-resistive detector element as a function of the frequency of the applied alternating current (col. 2, lines 15-45, for example). The reference further exemplifies such methods as providing high precision as compared to the prior art (col. 1, lines 30-45, for example).

Thus, in summary, it is submitted that it would have been *prima facie* obvious to a skilled artisan at the time of invention to utilize a driving source to vibrate the cantilever within Quake since the prior art demonstrates such a technique as useful for the detection of a target binding to a cantilever.

Furthermore, it would have been *prima facie* obvious to a skilled artisan at the time of invention to concentrate an uneven electric field at the immobilized oligonucleotides on the surface of the cantilever within the detection methods of Quake since the prior art suggests such a step to neatly align DNA molecules on the substrate.

Furthermore, it would have been *prima facie* obvious to a skilled artisan at the time of invention to incorporate a piezo-resistive element onto the cantilever within the detection methods of Quake to allow for the determination of cantilever vibration frequency since the prior art suggests such a step for high precision detection.

2. Claim(s) 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quate et al. (U.S. 6,203,983 B1) in view of Washizu et al. ("Electrostatic

manipulation of DNA in microfabricated structures," IEEE Trans. Ind. Applicat., vol. 26, pp. 1165-1172, 1990), and in further view of Wachter et al. (U.S. 5,445,008), and in further view of Daratchiev et al. (U.S. 6,457,360 B1) as applied to claim 1 above, and in further view of Yamamoto et al. (U.S. 5,268,571).

The teachings of the previously applied reference(s) have been outlined in the above rejections. The previously applied reference(s) do not expressly teach a cantilever having a piezoelectric material disposed between counter electrodes and subsequent vibration with application of AC voltage between the counter electrodes.

Yamamoto provides a supportive disclosure that teaches a microcantilever having a piezoelectric material disposed between counter electrodes and subsequent vibration with application of AC voltage between the counter electrodes (fig. 1; col. 4, lines 30-end, col. 5-6, example 1, for example). The reference shows the cantilever to have excellent responsiveness (col. 6, lines 25-35, for example).

Furthermore, it would have been *prima facie* obvious to a skilled artisan at the time of invention to utilize counter electrodes to vibrate a piezoelectric cantilever, such as those in Wachter, since the prior art demonstrates such a arrangement as useful for providing a cantilever with excellent responsiveness.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Babic whose telephone number is 571-272-8507. The examiner can normally be reached on Monday-Friday 7:00AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher M. Babic/
Patent Examiner
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